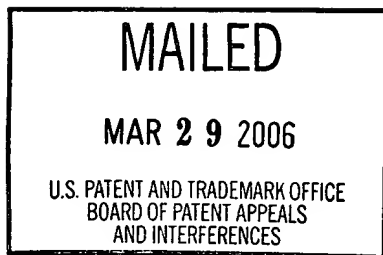


The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID VERCHERE



Appeal No. 2006-0530
Application No. 09/441,204

HEARD: March 7, 2006

Before FRANKFORT, BAHR and NAPPI, **Administrative Patent Judges.**
NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the rejection of claims 10 and 20 through 36, the only claims remaining in the application. For the reasons stated *infra* we reverse the examiner's rejection of these claims.

Invention

The invention relates to a system that provides a real-time exchange for all participants in the promotional products industry, including customers, resellers and vendors. See pages 4 and 5 of appellant's specification.

Claim 10 is representative of the invention and is reproduced below:

10. A computer implemented system for acquiring branded promotional products comprising:

a database containing product information wherein the product information comprises product data and imprinting data related to a plurality of branded promotional products;

a products web page where a customer or a reseller accesses the products web page to acquire at least one branded promotional products;

a reseller showcase web page where a customer accesses the reseller showcase web page to acquire at least one branded promotional products;

a vendor showcase web page where a reseller accesses the vendor showcase web page to acquire at least one branded promotional products;

a front office module for providing purchase order information and marketing information and receiving at least one order from one or more resellers or customers wherein the at least one order is related to the plurality of branded promotional products;

a bidding module for enabling at least one or more resellers or customers to present at least one order and enabling at least one vendor to bid on the presented order wherein the at least one order is related to the plurality of branded promotional products;

an artwork library for storing customer's logo and branding artwork associated with the plurality of branded promotional products; and

a processor for processing orders received from the front office module;

wherein the database, the products web page, the reseller showcase web page, the vendor showcase web page, the front office module, the bidding module, the artwork library and the processor are interoperably connected.

References

The references relied upon by the examiner are:

Conklin et al. (Conklin)	6,141,653	Oct. 31, 2000 (filed Nov. 16, 1998)
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Promomart: "www.promomart.com," Internet Archive Wayback Machine, www.archive.org," (January 1998).

Busch, Melanie, "Companies Spin Own Webs with Intranets," Tulsa World, (August 25, 1996).

Business Wire, "911gifts.com Expands Features, Service and Merchandise to Rescue Holiday Shoppers," (November 16, 1998).

Rejection at Issue

Claims 21 through 36 stand rejected under 35 U.S.C. § 101 as being as being drawn to non-statutory subject matter. Claims 10 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Conklin in view of Promomart.

Claims 21, 23 through 26 and 28 through 36 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Conklin in view of Promomart and Busch.

Claims 22 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Conklin in view of Promomart, Busch and Business Wire

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellant and the examiner, and for the reasons stated *infra* we do not sustain the examiner's rejection of claims 21 through 36 under 35 U.S.C. § 101 or the examiner's rejections of claims 10 and 20 through 36 under 35 U.S.C. § 103.

Rejection of claims 21 through 36 under 35 U.S.C. § 101

The examiner's rejection of claims 21 through 36 under 35 U.S.C. § 101 is set forth on page 5 of the Office Action dated August 10, 2004. The examiner's rejection asserts that the rejected claims are directed to an abstract idea and have "no practical application in the technological arts". Appellant argues on pages 8 through 11 of the brief that the claims are drawn to statutory subject matter as the proper test is whether the claimed steps perform concrete, tangible and useful results.

We agree with the appellant. In our recent precedential decision in *Ex parte Lungren*, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), we established that “there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under §101” *Lungren* at 76 USPQ2d 1388. Thus, we find that the examiner’s rejection is ill founded. Further, while the examiner identifies on page 5 of the Office Action mailed August 10, 2004, that *AT&T v. Excel Communications Inc.*, 172 F3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999) sets forth a concrete, tangible and useful test for patent eligible subject matter, the examiner does not provide any analysis or facts to support a finding that claims 21 through 36 do not produce a concrete, tangible and useful result. Accordingly, we hold that the examiner has not established sufficient facts or analysis to support a rejection under 35 U.S.C. § 101 and will not sustain the examiner’s rejection of claims 21 through 36 under 35 U.S.C. § 101.

**Rejection of claims 10 and 20
under 35 U.S.C. § 103**

The examiner’s rejection of claims 10 and 20 under 35 U.S.C. § 103 as being unpatentable over Conklin in view of Promomart, is set forth on pages 6 through 12 of the Office Action dated August 10, 2004.

Appellant argues, on page 13 of the brief, that the Conklin reference teaches a bi-level network between buyers and sellers, which is different than the claimed invention which provides a multi level network among sellers, resellers and vendors. Appellant points to the limitations of claims 10 and 20 which recite a products web page, a reseller showcase web page and a vendor showcase web page. Appellant further argues:

[T]he Office Action alleges that Conklin's disclosure of sellers meets the claim limitation of not only vendors, but resellers. However, by applying the overly broad definition proposed by the Office Action, the examiner has combined two distinct limitations into a single element thereby essentially eliminated [sic] the entire reseller limitation in the claims.

Appellant argues, on pages 16 through 18 of the brief, that Promomart does not make up for the alleged deficiencies in Conklin and that the examiner has not established a proper motivation to combine the references.

In response the examiner asserts, on page 4 of the answer, that Conklin teaches examples of online communities that demonstrate the versatility of a sponsored community, but is not limited to buyers and sellers, and that Conklin teaches multiple entry points. The examiner identifies a seller as "any entity engaged in selling- a reseller, a vendor, or supplier." Further, regarding the motivation to combine the references, the examiner states on page 6 of the answer:

Given the suggestion of potential uses by Conklin, the Appellant is confusing hindsight reconstruction with creative uses for the Conklin invention. Conklin and Promomart in combination teach and/or suggest an online community of participants engaged in the buying and selling of branded promotional products.

We disagree with the examiner's rationale. In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788. An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." ***In re Lee***, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In this case the examiner has presented no objective evidence that the combination of Conklin and Promomart teach all of the limitations of the claims or that one of ordinary skill in the art would have been motivated to combine the references as asserted.

Claim 10 contains limitations directed to “ a products web page where a customer or a reseller accesses the products web page”, “a reseller showcase web page where a customer accesses the reseller showcase web page”, “a vendor showcase web page where a reseller accesses the vendor showcase web page” and “a bidding module for enabling at least one or more resellers or customers to present at least one order and enabling at least one vendor to bid on the presented order.” Claim 20 contains similar limitations. Thus, claims 10 and 20 recite limitations directed to different access points and actions for three different entities, customers, resellers and vendors. Vendors bid on presented orders. Resellers present orders, and can access the vendor showcase web page as well as the products web page. Customers present orders and can access the reseller showcase web page and the products web page.

We find that Conklin teaches four entities involved in an interactive system for processing bids. The four entities are the buyer, seller, sponsor, and the commerce system provider. See column 14, lines 1 through 4, lines 11 through 14 and 31 through 38. The sponsor establishes standards for the community and the commerce provider administers the system, neither of which corresponds to one of the three entities recited in appellant’s claims. We do not find that Conklin teaches the interactions between the three parties as recited in the claims. Conklin’s buyer and seller may be equivalent to the claimed customer and vendor or Conklin’s seller may be a reseller. However, regardless of which claimed entity Conklin’s seller meets, vendor or reseller, the examiner has not shown, nor do we find that Conklin teaches an entity which meets the

other (i.e. if Conklin's seller meets the vendor there is no entity which meets the claimed reseller and if Conklin's seller meets the claimed reseller, there is no entity which meets the claimed vendor).

We find that Promomart teaches a system whereby a customer can access a web site to gain information on branded promotional products and receive a referral to a seller who produces the product. However, we do not find that Promomart teaches the interactions between the three parties as recited in the claims.

Additionally, we do not find that either Conklin or Promomart provides objective evidence that would have suggested the combination asserted by the examiner. For the forgoing reasons, we will not sustain the examiner's rejection of claims 10 and 20.

**Rejection of claims 21, 23 through 26 and
28 through 36 under 35 U.S.C. § 103**

The examiner's rejection of claims 21, 23 through 26 and 28 through 36 under 35 U.S.C. § 103 as being unpatentable over Conklin in view of Promomart and Busch, is set forth on pages 12 through 19 of the Office Action dated August 10, 2004.

On pages 19 and 20 of the brief, appellant states that independent claims 21 and 26 recite a system with a "vendor entry point interface", "a vendor showcase module" and "a reseller entry point interface." Appellant argues that Conklin teaches a bi-level network between buyers and sellers and fails to disclose the claimed entry points and modules. Further, on pages 21 through 23

of the brief appellant argues that Promomart and Busch do not make up for the alleged deficiencies in Conklin and that the examiner has not established a proper motivation to combine the references.

In response the examiner states, on page 7 of the answer, that Busch was cited as teaching the limitation of a company logo store and that Conklin and Promomart teach multiple entry points and modules as discussed with respect to claims 10 and 20.

We disagree with the examiner's rationale. Independent claim 21 and 26 each recite several limitations which are directed to the interrelations between the vendor, reseller and customer. We consider the scope of claim 21 to include an entry point which allows the vendor to enter data into the product database, where the vendor is the entity who supplies the products and imprinting service. Similarly, claim 21 recites a reseller entry point where resellers can obtain ordering access to the system where the reseller is the entity that resells products to customers. Claim 26 contains similar limitations, thus, we find that independent claims 21 and 26 recite three distinct entities. As discussed *supra*, we do not find that the combination of Conklin and Promomart teach a system where a vendor, reseller and customer interact. The examiner has not asserted, nor do we find that Busch teaches that the systems of Conklin and Promomart should be modified to include such an interaction. Accordingly, we will not sustain the examiner's rejection of 21, 23 through 26 and 28 through 36

**Rejection of claims 22 and 27
under 35 U.S.C. § 103**


The examiner's rejection of claims 22 and 27 under 35 U.S.C. § 103 as being unpatentable over Conklin in view of Promomart, Busch and Business Wire, is set forth on pages 19 and 20 of the Office Action dated August 10, 2004.

Claims 22 and 27 are dependent upon claims 21 and 26, respectively. As discussed *supra*, we do not find that the combination of Conklin, Promomart and Busch teach the limitations of claims 21 and 26. The examiner has not asserted nor do we find that the Business Wire article provides a teaching or suggestion to modify the system of Conklin to include the claimed interactions between the vendor, reseller and customer. Accordingly, we will not sustain the examiner's rejection of claims 22 and 27.

In summary, we do not sustain the examiner's rejection of claims 21 through 36 under 35 U.S.C. § 101 or the examiner's rejections of claims 10, 20 through 36 under 35 U.S.C. § 103. The decision of the examiner is reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2006-0530
Application No. 09/441,204

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